

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF C. HAWKINS and JOHN J. DALY

Appeal No.1997-1349
Application 08/520,629¹

ON BRIEF

Before HAIRSTON, KRASS, and FLEMING, **Administrative Patent Judges.**

¹ Application for patent filed August 29, 1995. According to Appellants, this application is a continuation of Application No. 08/215,988, filed March 22, 1994, now abandoned; which is a continuation of Application No. 08/025,900, filed March 3, 1993, now U.S. Patent No. 5,333,116, issued July 26, 1994; which is a continuation of Application No. 07/932,515, filed August 20, 1992, now abandoned; which a continuation of Application 07/839,004, filed February 14, 1992, now U.S. Patent No. 5,200,913, issued April 6, 1993; which is a continuation of Application No. 07/519,031, filed May 04, 1990, now abandoned.

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FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24 through 54, 56, 57, and 79 through 82, all of the claims presently pending in the application.

The invention is directed generally to a portable pad computer having a display operable by a conductive pointed stylus as well as a keyboard in a housing for entry of data into the computer. More specifically, as disclosed on pages 4 and 5 of the specification and Fig. 1, the computer is operable as a pad computer when the display is closed onto the housing 10 with the viewing surface 21 exposed. In its open position, as shown in Fig. 2, the computer is operable as a laptop allowing entry of data using the keyboard 15. The display is further disclosed on page 6 of the specification and in Fig. 4 to be connected to the housing by a pair of hinges 40 that are pivotally attached at one end to the side of display and at the other end to the side of the housing. Additionally, as disclosed on page 6 and Figs. 2 and 3, a rear

hinge plate 41 is attached to the rear surface 27 of the display and to the housing 10 near its rear portion.

Representative independent claims 24, 46, and 79 are reproduced as follow:

24. A portable computer comprising:

a computer housing;

a keyboard carried by said computer housing;

a display device having an obverse viewing surface and a reverse surface; and

a mounting assembly for coupling said display device to said computer housing, said mounting assembly including an integral, single-piece, member extending between said display device and said computer housing, said integral, single-piece, member having a first end portion connected to said computer housing in a substantially non-slidable manner and a second end portion connected to said display device, said display device being adjustable between a closed position in which the display device covers the keyboard with said reverse surface and an open position in which the keyboard is uncovered and the display device is positioned rearwardly of the keyboard at a viewing angle.

46. A portable computer comprising:

a housing, said housing comprising logic means and an integral keyboard, said logic means connected to receive user input from said keyboard; and

a display connected to said housing, said logic means adapted to receive user input from said display and provide output to said display based on said input from said keyboard, said display being operable in conjunction with a stylus; and

first and second engagements for enabling removable attachment of a stylus to said computer in first and second positions, respectively, said first position relatively vertical to said housing, said second position relatively parallel to said housing.

79. A portable computer comprising:

a computer housing;
a keyboard carried by said computer housing;

a display device having an obverse viewing surface and a reverse surface;

one or more electrical conductors extending between said display device to said computer housing; and

a mounting assembly for coupling said display device to said computer housing, said mounting assembly including a first mounting element extending between said display device and said computer housing, said mounting element having a first end portion connected to said computer housing and a second end portion connected to said display device, said mounting assembly further including a second mounting element having a first end portion coupled to said reverse surface of said display device and a second end portion coupled to said computer housing for supporting said electrical conductor;

wherein said display device is adjustable between a closed position in which the display device covers the keyboard and an open position in which the keyboard is uncovered and the display device is positioned rearwardly of the keyboard at a viewing angle.

The Examiner relies on the following references:

Cohen et al. (Cohen)	4,238,792	Dec. 9, 1980
Nigro, Jr. et al. (Nigro)	4,742,478	May 3, 1988

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Takach, Jr. et al. (Takach) 1987)	4,830,328	May 16, 1989 (Filed April 24,
Holmberg	4,851,812	Jul. 25, 1989 (Filed June 7, 1988)
Hawkins et al. (Hawkins)	5,200,913	Apr. 6, 1993

Kunii	63-39 731	Mar. 15, 1988
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Claims 24, 25, 31 through 33, 37, 38, 43, 56, and 79 through 82 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii. Claims 26 through 30 and 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii and Takach. Claims 34 through 36 and 45 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii and Holmberg. Claims 39, 40, 46 through 48, 54, and 57 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii and Cohen. Claims 49 through 52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii, Cohen, and Takach. Claim 53 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kunii, Cohen, and Nigro. Claims 41 and 42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kunii and Nigro. Claims 24 through 54, 56, 57, and 79 through 82 stand rejected under the judicially created doctrine of obviousness-type double patenting over Hawkins.

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Rather than repeat the arguments of Appellants and the Examiner, we make reference to the brief² and the answer for the details thereof.

OPINION

It is our view, after careful review of the evidence before us, that claims 24 through 31, 34 through 45, 56, and 57 are properly rejected under 35 U.S.C. § 103. We reach the opposite conclusion with respect to claims 32, 33, 46 through 54, and 79 through 82. We further find that claims 24 through 54, 56, 57, and 79 through 82 are properly rejected under the judicially created doctrine of obviousness-type double patenting. Accordingly, we affirm.

At the outset, we note that Appellants on page 5 of the brief point out the groupings of the claims. 37 C.F.R. § 1.192(c)(7) (July 1, 1996) **as amended at** 60 Fed. Reg. 14518

² Appellants filed an appeal brief on October 4, 1996. Appellants also filed a reply brief on February 25, 1997. On May 9, 1997, the Examiner mailed a communication stating that the reply brief has not been entered.

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(March 17, 1995), which was controlling at the time of Appellants' filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Although Appellants have provided a statement regarding the groupings of the claims, Appellants have not in the arguments section of the brief provided specific arguments entirely consistent with these groupings. We note that the arguments made for the independent claims 24 and 43 are the same. Additionally, Appellants only repeated what some of the dependent claims recite without any additional arguments set forth. We will, thereby, consider Appellants' claims as standing or falling together as follows: for the rejection of claims 24, 25, 31 through 33, 37, 38, 43, 56, and 79 through 82 under 35 U.S.C. § 103 over Kunii, claims 24, 25, 31, 37, 38, 43, and 56 will be treated as a group and we will treat claim

24 as a representative claim of that group while claims 79 through 82 will be treated as a group and we will treat claim 79 as a representative claim of that group; claims 26 through 30 and 44 will be treated separately; claims 34 through 36 and 45 will be treated separately; for the rejection of claims 39, 40, 46 through 48, 54, and 57 under 35 U.S.C. § 103 over Kunii and Cohen, claims 39, 40, and 57 will be treated as a group and we will treat claim 24 as a representative claim of that group because Appellants only argue the limitations recited in claim 24 for these claims; claims 41 and 42 will be treated separately. For the rejection under the judicially created doctrine of obviousness-type double patenting, we will treat claims 24 through 54, 56, 57, and 79 through 82 as a single group and will treat claim 24 as a representative claim of that group.

It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when

determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996) ***citing W.L. Gore & Assoc., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984). It is further established that "Under 35 U.S.C. § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests." ***In re Baird***, 16 F.3d 380, 383, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994), ***citing In re Burckel***, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

Turning to the rejection of claims 24, 25, 31, 37, 38, 43, and 56 under 35 U.S.C. § 103, Appellants argue on pages 5 and 6 of the brief that Kunii does not teach a mounting assembly which is an integral, single piece member connected between the display and the housing in a substantially non-slidable manner as defined in Appellants' independent claim 24. Appellants on page 6 of the brief point out that Kunii's display 1 is moved from the open position in Fig. 1A to its closed position where

the display covers the keyboard with its reverse surface by sliding the hinge 6 along a slide rail 7 to point "b" and then pivoting the housing in the reverse direction about hinge 6 as shown in Fig. 1C. Appellants further argue that the slide rail 7 and the hinges 6 of Kunii are not an integral, single piece member. Appellants on page 7 of the brief add that the closed and the open positions, as recited in claim 24, correspond to the positions shown in Kunii's Figs. 1A and 1C respectively which require the use of the "slidable feature" of the hinges 6 and the slide rail 7.

The Examiner on page 3 of the answer responds to Appellants' arguments by stating that Kunii does show an integral, single piece member having two ends extending between and connected to the display and the housing by the hinges 6. The Examiner further points out that the closed and the open positions corresponding to Kunii's Figs. 1A and 1B do not require using the slidable feature of the rail 7.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." ***In re Hiniker Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Claims will be given their

broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. ***In re Etter***, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We note that Appellants' claim 24 recites

. . . said display device being adjustable between a closed position in which the display device covers the keyboard with said reverse surface and an open position in which the keyboard is uncovered and the display device is positioned rearwardly of the keyboard at a viewing angle (emphasis added).

We fail to find that Appellants' claim 24 requires any particular angle or direction for the display surface with respect to the keyboard in its open position. Appellants specifically recite a closed position for the computer where the display covers the keyboard in the housing with its reverse surface. Nevertheless, Appellants define the open position merely by reciting that the keyboard is uncovered and the display is at a viewing angle positioned on the back portion of the keyboard. Thus, Appellants' claim 24 does not preclude an open position with the display at a viewing angle while the viewing surface is positioned away from the keyboard.

Kunii teaches a portable computer where the display 1 is attached to the housing 5 via a mounting assembly that is directly connected at one end to the display and at the other end to the housing by hinges 6. Kunii on page 5 teaches that once the hinge 6 is moved to one of the end points "b" or "c", the connection remains substantially non-slidable while the display is pivoted around the hinge for positioning it at any angle. Kunii further teaches that the display pivots about the hinge 6 and includes a balancing function for placing the display at any desired angle. Figs. 1A and 1B further show closed and open positions when the hinge 6 is at one end without using the rail 7. Similarly, it is clear from Kunii's disclosure and Fig. 1C that once the mounting member is at the other end point "b", it does not require the mounting assembly to slide in the rail 7. Rather, the hinge 6 clicks and remains fixed at the end point "b" while the display pivots about the hinge 6 to either open at a viewing angle to uncover the keyboard or close to expose the viewing surface.

We agree with the Examiner that Kunii's Figs. 1A and 1B show the closed and the open positions without using the slidable feature of the rail 7 once the mounting member is at

the end point "c". However, while we agree that changing the configuration in Fig. 1A to that of Fig. 1C requires sliding the mounting element in rail 7, we note that Kunii's Fig. 1C alone shows the open or closed position without using the slidable feature as recited in Appellants' claim 24.

Therefore, we conclude that Kunii's mounting assembly is an integral, single piece, member allowing the display to open and close while the mounting member remains at one end of the housing in a substantially non-slidable manner.

Appellants on pages 8 and 9 further argue that Kunii does not suggest any reason for the modification to the hinges when the display is closed. Appellants point out that Kunii's mounting assembly is configured such that the modification to obtain a non-slidable connection for opening and closing the display without sliding the mounting assembly would have been impossible.

The Federal Circuit states that "[o]bviousness from [prior art reference] would follow, ipso facto, if [prior art reference] anticipates." ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 780 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), ***citing***

In re Kalm, 378 F.2d 959, 962, 154 USPQ 10, 12 (CCPA 1967), (anticipation stated as being the "epitome of obviousness"). It is further established that "[l]ack of novelty is the ultimate of obviousness." See ***In re Fracalossi***, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

We find that Kunii in Fig. 1C provides a single piece mounting assembly that allows the display to pivot about the connecting hinge 6 which is fixed at the end point "b". Thus, without any modifications, Kunii teaches that the display opens to a viewing angle to uncover the keyboard while it covers the keyboard with its reverse surface in closed position.

Therefore, we conclude that Kunii anticipates and ultimately renders obvious the pad computer as recited in claim 24.

Accordingly, we affirm the Examiner's rejection of claims 24, 25, 31, 37, 38, 43, and 56 under 35 U.S.C. § 103 over Kunii.

Turning to the rejection of claims 26 through 30 and 44, Appellants on pages 14 and 15 argue identical points as discussed above in relation with the mounting element recited in claims 24 and 43. Accordingly, we affirm the rejection of claims 26 through 30 and 44 under 35 U.S.C. § 103 over Kunii and Takach.

In regard to the rejection of claims 34 through 36 and 45, Appellants on pages 9 and 15 of the brief make arguments similar to those made for claim 24 and add that Kunii does not teach a pair of mounting elements for connecting the display to the housing. We note that Kunii does teach a pair of mounting elements by showing one element in a side view of the housing and implicitly showing a second element at the other side of the housing. Therefore, we affirm the rejection of claims 34 through 36 and 45 under 35 U.S.C. § 103 over Kunii and Holmberg.

Turning to the rejection of claims 39, 40, and 57, Appellants on page 16 of the brief argue that Cohen's stylus is not attached to different points corresponding to the operating positions of the screen. However, Appellants on page 17 of the brief acknowledge that Cohen does teach attachment of a stylus at a single point. We fail to find any different "operating positions" in these claims which merely recite a stylus attached to a region adjacent the viewing surface. Additionally, we find that Cohen in col. 3, lines 11 through 16 does teach that the stylus 13 is mounted on a mask area adjacent the viewing surface 15. We agree with the Examiner

that it would have been obvious to modify Kunii's portable computer with Cohen's stylus since, as disclosed by Cohen in col. 2, lines 2 through 6, attaching the stylus to the display device provides a more efficient work area for the computer operator. Therefore, we affirm the rejection of claims 39, 40, and 57 under 35 U.S.C. § 103 over Kunii and Cohen.

In regard to the rejection of claims 41 and 42, Appellants on pages 18 and 19 repeat the argument that the nonslidable movement of the mounting assembly and the reverse surface of the display covering the keyboard as recited in the independent base claim 24 are not taught by the combination of Kunii and Nigro. For the reasons discussed above in regard to claim 24, we find that claims 41 and 42 are properly rejected under 35 U.S.C. § 103 over Kunii and Nigro.

In view of the discussions above as related to the independent claim 24 and each group of the claims, we find that Kunii, Takach, Holmberg, Cohen, and Nigro, alone or in combination, teach the claimed pad computer. Accordingly, we affirm the rejection of claims 24 through 31, 34 through 45, 56, and 57 under 35 U.S.C. § 103.

In regard to the rejection of claims 32 and 33, Appellants on pages 9 and 10 of the brief argue that Kunii does not show a rear hinge coupled to the reverse surface of the display device. Appellants add that the rear hinge is recited as a relatively rigid sheet. Appellants specifically point to the recitation of both a single piece mounting member and a rear hinge means.

The Examiner on page 4 of the answer responds to Appellants' arguments by stating that the hinge as taught by Kunii corresponds to the claimed rear hinge means with a rigid sheet since claim 32 does not require two distinct elements for connecting the display and the housing. The Examiner further states that Kunii's hinge is coupled to the reverse surface.

In determining the scope of claim 32, we agree with Appellants that there are two distinct connecting elements. Claim 32 does recite "mounting means" separate from the "mounting assembly" as recited in the independent claim 24. Therefore, claim 32 recites a mounting assembly including a single-piece member as well as mounting means including a rear hinge coupled to the reverse surface of the display.

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We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a **prima facie** case. **In re Piasecki**, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); **In re Knapp-Monarch Co.**, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); **In re Cofer**, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in **In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in **Graham v. John Deere Co.**, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103." **Citing In re Warner**, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

After a review of the teachings in Kunii, we fail to find additional mounting means including rear hinges coupled to the reverse surface of the display. We disagree with the Examiner that Kunii's hinge 6 is coupled to the reverse surface of the

display. We find that the hinges 6 as disclosed by Kunii are attached to the side surfaces of the display. Accordingly, we reverse the rejection of claims 32 and 33 under 35 U.S.C. § 103 over Kunii.

Turning to the rejection of claims 46 through 54, Appellants argue on pages 16 and 17 of the brief that Cohen does not teach "first and second engagement . . . for attachment of a stylus . . . in first and second positions" where the positions are further recited to be vertical and parallel in relation to the housing. Appellants point out that the Examiner provides no suggestion for two attachments and their relative positioning.

The Examiner on page 6 of the answer responds to Appellants' arguments by stating that it would have been obvious to one of ordinary skill in the art to attach the stylus in two positions. The Examiner further argues that Kunii's computer has dual operating positions and thus suggests "two" attachments, one for each operating position.

Claim 46 requires two engagements for attaching a stylus in a vertical position and a parallel position relative to the housing. Cohen in Fig. 1 and col. 3, lines 13 and 14 discloses

a stylus attached to the display in a single parallel position. However, we find that Cohen neither teaches nor suggests any additional stylus positions or attachments other than the one depicted in Fig. 1. Accordingly, we reverse the rejection of claims 46 through 54 under 35 U.S.C. § 103 over the different combinations of Kunii, Cohen, Takach, and Nigro.

Turning to the rejection of claims 79 through 82, Appellants on pages 12 through 14 of the brief argue that the second mounting element including rear hinges connected to the reverse surface of the display, as recited in claim 79, is not taught by Kunii. Appellants state that Kunii is also silent with regard to the second element supporting flexible electrical conductors for electrically coupling the display and the housing.

The Examiner on page 4 of the answer argues that Kunii's keyboard and the display are inherently connected by electrical conductors. In addition to above arguments related to the independent claim 24, the Examiner further states that Kunii's hinge does show the second mounting element as recited in the independent claim 79.

As discussed above in regard to claim 32, we fail to find a second mounting element coupled to the reverse side of the display in Kunii's computer. Therefore, we reverse the rejection of claims 79 through 82 under 35 U.S.C. § 103 over Kunii.

Turning to the rejection of claims 24 through 54, 56, 57, and 79 through 82 under the judicially created doctrine of obviousness-type double patenting, Appellants do not make any arguments and offer to submit a terminal disclaimer after allowable claims are indicated. Accordingly, we affirm the rejection of claims 24 through 54, 56, 57, and 79 through 82 under the judicially created doctrine of obviousness-type double patenting.

In view of the forgoing, the decision of the Examiner rejecting claims 32, 33, 46 through 54, and 79 through 82 under 35 U.S.C. § 103 is reversed. The decision of the Examiner rejecting claims 24 through 31, 34 through 45, 56, and 57 under 35 U.S.C. § 103 is affirmed. The decision of the Examiner rejecting claims 24 through 54, 56, 57, and 79 through 82 under the judicially created doctrine of obviousness-type double patenting is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R. §
1.136(a).

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
ERROL A. KRASS)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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